

**REMARKS**

Applicants respectfully request entry of the above amendments and consideration of the foregoing remarks.

**Status of claims**

Claims 1, 3, 10, 11, and 15 are requested to be amended.

Support for the amendment to claim 1 can be found in claim 2 (now canceled) and in the specification, *e.g.*, at page 4, lines 11-16 and page 5, lines 18-27. Particular support for the language “a stainless steel or titanium material,” can be found, for example, at page 6, lines 1-7.

Support for the amendment to claim 3, which deletes “hydrophobic” and inserts “lubricious,” can be found, for example, at page 7, lines 11-16.

The amendments to claims 10 and 11 add parentheses to reference characters that are recited throughout the specification.

The amendment to claim 15 clarifies the meaning of the term “TEFLON.”

Claim 2 is requested to be canceled.

Claims 16 and 17 are requested to be added. Support for the new claims can be found, for example, at page 7, lines 11-16.

No new matter has been added.

In the remainder of the Response, Applicants address each outstanding objection and rejection, using the paragraph (¶) numbers provided in the Office Action of July 14, 2004.

## Objections

¶ 1. The specification was objected to for the recital of “the guidewire” at page 1, line 8. The specification has been amended to recite “a guidewire,” which addresses the rejection.

¶ 2. Claim 10 was objected to for lacking of a colon following “comprising” in line 4. A colon has been added to address the rejection.

¶¶ 3-4. Claims 10-15 were objected to for reciting reference characters that were not enclosed in parentheses. Claims 10 and 11, from which claims 12-15 depend, have been amended to add parentheses around the reference characters, D<sub>i</sub> and L, to address the rejection.

## Rejections

¶¶ 5-7. Claim 15 was rejected under 35 U.S.C. § 112, 2<sup>nd</sup> ¶, as being indefinite for the recitation of Teflon.

According to the Patent Office’s own M.P.E.P., trademarks may be used in patent application if their meanings are established by accompanying definitions *or* well-known and satisfactorily defined in the literature, at the time of filing. § 608.01(v). Teflon is well-known in the literature. For example, the word appears in the Fourth Edition of Hackh’s Chemical Dictionary (1969) as well as the 12<sup>th</sup> Edition of the Merck Index (1996) and Webster’s 9<sup>th</sup> New Collegiate Dictionary (1989).

Nonetheless, claim 15 has been amended to recite “TEFLON (polytetrafluoroethylene)” to clarify the claim language. No new matter has been added because Teflon was well-known in the art before the filing date of the application.

¶¶ 8-9. Claims 1, 2, 4, and 5 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Muni *et al.*, U.S. Patent No. 6,190,332.

The above amendments address the rejections. Claim 1, from which claims 3-5 depend, now recites “providing a wire having an initial diameter greater than the maximal diameter of the guidewire [and] reducing by center-less grinding the initial diameter of the wire to a diameter not exceeding the maximal diameter of the guidewire.”

The new claim language distinguishes the claimed method from that of Muni, which does not disclose a finished guidewire that is produced by reducing by center-less grinding the diameter along the entire length of core wire. Muni discusses center-less grinding only with respect to a tapered configuration at the distal end of the guidewire (column 6, lines 7-13).

¶¶ 10-11. Claims 3, 8, and 9 were rejected under 35 U.S.C. § 103 as allegedly being obvious over Muni (6,190,332) in view of Cornish (6,132,389).

The above amendment to claim 1, from which 3, 8 and 9 depend, presumably obviates the rejection. The pending claims are now drawn to a guidewire produced by centerless grinding a larger initial diameter segment of wire along its entire length. These limitations are not disclosed by Muni.

Cornish was cited for its disclosure of lubricious coatings. Corning provides no disclosure effective to cure the defect in Muni, with respect to the now-claimed subject matter. Accordingly, the combination of Muni and Corning does not produce the claimed invention.

¶ 12. Claims 6, 7, and 10-13 were rejected under 35 U.S.C. § 103 as allegedly being obvious over Muni in view of “Applicant’s Admitted Prior Art (AAPA).”

Applicants presume that the Office Action is referring to a references cited in the Background section of Applicants application, which provides a context in which one skilled in the art can readily appreciate the novelty of the instant invention. The term “prior art” has legal significance and Applicants resist the indiscriminate use of the term to refer to cited references.

Notwithstanding these semantic distinctions, Applicants submit that the above amendments, requiring the guidewire to be center-less ground along its entire length, obviates the rejection.

¶ 13. Claims 14 and 15 were rejected under 35 U.S.C. § 103 as allegedly being obvious over “Muni/AAPA” in view of Cornish.

Applicants submit that the above amendments, requiring the guidewire to be center-less ground along its entire length, obviates the rejection.

¶ 14. The Examiner notes that Muni discloses the use of a stainless steel wire, contrary to the assertion by Applicants’ attorney.

Applicants are grateful to the Examiner for making this fact of record and potentially averting disaster should the instant application ever be the subject of litigation. Applicants’ attorney apologizes for the mistake, which was most assuredly made without deceptive intent.

### **CONCLUSION**

Applicants believe that the present application is now fully in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

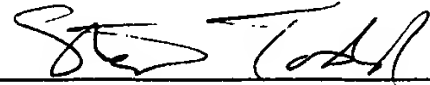
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even

entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date: January 12, 2005

By \_\_\_\_\_

FOLEY & LARDNER LLP  
1530 Page Mill Road  
Palo Alto, California 94304-1125  
Telephone: (650) 251-1155  
Facsimile: (650) 856-3710

Stephen Todd  
Attorney for Applicant  
Registration No. 47,139